IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **KAPLAN, Diego**	Group Art Unit: **2152**
Application Serial No.: **10/091,311**	Examiner: **TRUONG, Lan Dai T.**
Filed: **March 04, 2002**	Conf. No.: **8151**
Title: **SYSTEM AND METHOD FOR OPTIMAL SHORT MESSAGE SERVICE (SMS) ENCODING IN A WIRELESS COMMUNICATIONS DEVICE**	

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Dear Sir:

APPELLANT'S REPLY BRIEF UNDER 37 CFR 41.41

In response to the Examiner's Answer mailed December 26, 2007, in the above-identified U.S. Patent application, Appellants hereby present the Appellants' Reply Brief under 37 CFR §41.41.

ARGUMENT

As presented in Appellant's Appeal Brief, Appellant respectfully submits that the combination of references do not teach or suggest all of the limitations of any one of the claims and that the combination is improper. Appellant's Appeal Brief sets forth the reasoning regarding the two issues and, in the interest of brevity, Appellant limits this Reply Brief to addressing arguments raised in the Examiner's Answer.

A. REJECTION OF CLAIMS 11-17 UNDER 35 U.S.C. §103(A) - LEE IN VIEW OF MOSKOWITZ IS IMPROPER SINCE LEE AND MOSKOWITZ DO NOT TEACH OR SUGGEST SUPPLYING AN OPTIMIZING SIGNAL "PRIOR TO CHARACTER ENCODING OF THE SMS MESSAGE"

Appellant respectfully submits that the references do not teach supplying an optimizing signal "prior to character encoding of the SMS message". The Examiner argues at Page 11, lines 11-13:

"Moskowitz clear teaches different numbers of the character coding for encoding message prior to its transmission (lines 1-8), this section clearly teaches supplying signal prior to encoding message."

The claims, however, recite supplying an optimizing signal "prior to character encoding of the SMS message" not prior to transmission. In the section cited by the Examiner, Moskowitz states that "[t]he transmitter encodes the message that is to be sent to the receiver according to each format. The format which required the fewest number of bits to represent the entire message is selected as the character encoding format." (Emphasis added). Accordingly, the message is encoded before selecting an encoding format and an optimizing signal cannot possibly be supplied prior to character encoding in Moskowitz.

B) REJECTION OF CLAIMS 11-17 UNDER 35 U.S.C. §103(A) - LEE IN VIEW OF MOSKOWITZ IS IMPROPER SINCE LEE AND MOSKOWITZ DO NOT TEACH A "CHARACTER ENCODING SUBSYSTEM WITH AN INPUT TO ACCEPT AN SMS MESSAGE"

On page 12, lines 1-7 of the Examiner's Answer, the Examiner argues that Lee teaches "a character encoding subsystem with an input to accept an SMS message." Appellant respectfully submits that Lee does not teach this feature. The only discussion within Lee regarding the encoder/decoder appears at column 2, lines 31-46 which states:

"An RF (Radio Frequency) module 15 demodulates an RF signal received from an antenna 14 and outputs the modulated RF signal to an encoder/decoder 16. Further, the RF module 15 modulates a signal input from the encoder/decoder 16, converts the modulated signal to an RF signal and radiates the RF signal through the antenna 14.

The encoder/decoder 16, which is generally a chip specifically designed for use in a CDMA or PCS terminal, encodes the signal generated by the CDMA or PCS terminal under the control of the controller 10 and outputs the encoded signal to the RF module 15. In addition, the encoder/decoder 16 decodes the signal input from the RF module 15 by the CDMA or PCS terminal and outputs the decoded signal to the controller 10".

Appellant respectfully submits that nothing in this section indicates that the encoder/decoder 16 is a character encoder. On the contrary, it appears that this section indicates that the encoder/decoder 16 is signal encoder for CDMA.

The Examiner relies on Lee for support that a character encoding subsystem having an input to accept an optimizing signal is show in the references. As discussed above, Appellants submit that Lee does not show a character encoding subsystem. Further, nothing in Lee suggest that the encoder/decoder has an input that determines the type of encoding that is applied based on a signal received at the input. Assuming

arguendo, that Lee shows a character encoder with an input for accepting a control signal that dictates the type of encoding, Appellant submits that the combination of Moskowitz and Lee is an improper application of 35 U.S.C. § 103.

The Supreme Court stated that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007).*The operative question in this "functional approach" is, therefore, "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. Appellants respectfully submit that the Examiner's combination of Moskowitz and Lee is not a combination of familiar elements according to known methods that yields predictable results. The Examiner proposes to significantly alter the teachings of Lee by requiring that the encoder receive an optimizing signal. Lee does not indicate that a control signal can be received to optimize character encoding. Accordingly, the Examiner is applying the teaching of Moskowitz of encoding a message with different encoding schemes to determine the scheme that requires the fewest bits to modify the encoder in Lee to be able to receive an optimizing signal. Accordingly, such an encoder is not a "familiar element". Accordingly, the case at hand is not a situation where one with ordinary skill in the art would replace an encoder/decoder with an encoder responds to an optimizing signal. The substitution of the encoder/decoder of Lee with an encoder that responds to an optimizing signal is not a "predictable use of prior art elements according to their established functions."

The Supreme Court warned that "[a] fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *Id.* at 1742. Appellant respectfully submits that the cited prior art is only combined in retrospect, in light of the present invention. That is, the obviousness rejection is based upon characterization of Lee and Moskowitz in view of the Appellant's own invention description. Appellant respectfully submits that the Examiner has combined the references by observing that Lee does not teach or suggest optimizing character encoding and that Moskowitz includes a discussion of encoding a message is several formats and selecting the format that requires the least number of bits. Appellant respectfully submits that Examiner is constructing the claimed invention by

using Appellant's teaching of selecting an optimum format before encoding a message to form a combination that adds functionality to the encoder of Lee based on a character encoding selection technique in Moskowitz.

Conclusion

Appellant respectfully submits that the pending claims are allowable and that the rejections should be reversed.

Respectfully Submitted,

Dated: February 11, 2008

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